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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
NARUTOSHI FUKUZAWA : EXAMINER: GOMA, T.A.
SERIAL NO: 10/657,244 :
FILED: SEPTEMBER 9, 2003 : GROUP ART UNIT: 2627
FOR: OPTICAL RECORDING MEDIUM :
AND OPTICAL
RECORDING/REPRODUCING METHOD

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated July 11, 2008 (Answer).

The statement of the Grounds of Rejection (Answer at 3-7) is identical to the statement in the Rejection dated November 26, 2007, which has already been responded to in the Appeal Brief. The following is in reply to the "Response to Argument" (Answer at 7-8).

The Examiner finds that Kasada et al "specifically discloses the use of a methomethine [sic, monomethine] cyanine dye having organic dye compounds wherein both ends of the monomethine chain are composed of benzimidazole, indolenine, benzoselenazole, benzothiazole, or quinoline," relying on Kasada et al at column 14, lines 49-67 through column 15, lines 1-9 (Answer at 7).

In reply, the disclosure cited by the Examiner is with regard to other organic dye compounds usable in combination with the monomethine cyanine dyes of Kasada et al's

invention (column 14, lines 49-50). Indeed, as pointed out in the Appeal Brief, Kasada et al's inventive monomethine cyanine dyes, which is what the Examiner has been relying on in support of the rejections, are represented by Formulae 2 through 8 therein. While in said Formulae 2-5, Z may be quinoline (column 3, lines 38-40), and thus, quinoline may be a moiety in a heterocyclic nitrogen-containing group therein, the heterocyclic nitrogen-containing group *per se* cannot be quinoline, as pointed out in the Appeal Brief at page 6.

While the Examiner concedes the breadth of Kasada et al, the Examiner finds that the fact that Kasada et al discloses subject matter outside the terms of the present claims "is irrelevant to the grounds of the rejection because [Kasada et al] specifically discloses the use of applicant's composition" (Answer at 8).

In reply, the breadth of Kasada et al's disclosure and the relative narrowness of the presently-claimed invention is relevant. Indeed, *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994), which was cited in the Appeal Brief, is highly pertinent yet was not even addressed in the Answer.

In response to Applicant's arguments that Kasada et al does not disclose monomethine cyanine dyes having a minimum value n_{\min} of their refractive index within the terms of the present claims, the Examiner finds that "this argument is not persuasive because the refractive index of a material is inherent to the particular material. [Kasada et al's] disclosure of the same monomethine cyanine dyes used by applicant satisfies the limitation regarding the refractive index because the same material inherently has the same refractive index" (Answer at 8).

In reply, the rejection herein is one of non-patentability under 35 U.S.C. § 103(a), not anticipation under 35 U.S.C. § 102. Of course, a material's refractive index, like any other intrinsic property, is inherent in the material itself. But the minimum value n_{\min} of the refractive index of the present claims is **not** inherent in all the monomethine cyanine dyes

covered by Kasada et al's disclosure. Indeed, the dyes of Chemical Formulae 2 and 5 of Kasada et al (column 5) are substantially similar to cyanine dye "a" of Comparative Example 1 of the specification herein, the only differences being that while cyanine dye a contains an ethyl group attached to each of the nitrogen atoms, the dye of Chemical Formula 2 contains a methyl group attached to each nitrogen atom, and Chemical Formula 5 contains an ethyl group attached to one nitrogen and a methyl group attached to the other nitrogen. As the data in Table 1 at page 38 of the specification herein shows, cyanine dye a has a minimum value n_{\min} of its refractive index at a wavelength that is outside the 370-425 nm range of the present claims. The dyes of Chemical Formulae 2 and 5 of Kasada et al would be expected to also have a minimum value n_{\min} at a wavelength that is outside the terms of the present claims.

When Comparative Example 1, using cyanine dye a, is compared to Examples 1 and 2, which are according to the presently-claimed invention, in recording/reproducing tests described in the specification beginning at page 39, line 1, good signal characteristics were obtained for Examples 1 and 2, whereas the degree of modulation was small and the C/N ratio was insufficient after recording for Comparative Example 1.

For all the above reasons, Applicant continues to maintain that the rejections should be REVERSED.

Respectfully submitted,

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